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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/824,244	04/03/2001	Alain Bethune	05725.0875-00	8888

22852 7590 01/13/2005

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EXAMINER

SPERTY, ARDEN B

ART UNIT PAPER NUMBER

1771

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/824,244  
Filing Date: April 03, 2001  
Appellant(s): BETHUNE ET AL.

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Jay Stellacone  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 11/02/04.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

Claims 1-13: The summary of invention contained in the brief is deficient because the description of the claimed invention and the included drawings are inconsistent with each other and with the originally filed specification and drawings.

Firstly, the decorative pattern 6 of the drawings currently in the application is different from the decorative pattern 6 of the description in the Appeal Brief. For examination, the claims were interpreted according to the drawings submitted with the application. The claims were not interpreted according to the drawings in the Appeal

Brief. The designation of elements in the drawings of the Appeal Brief is different from the drawings used to interpret the examined invention, and the changed designation of elements changes the invention. Applicant is entitled to the originally examined invention by original presentation. Changing the elected invention is impermissible.

Secondly, the shading of the drawings in the Appeal Brief indicates 10, 11, 12 as one coating, with a second coating made of two crosshatched layers in Fig 2B and one crosshatched layer in Fig 2C formed separately from layers 10, 11 and 12. In other words, the change in shading indicates that the two crosshatched layers in Fig 2B are not merely uncovered portions of layers 10 and 11. The crosshatched layer of Fig 2C indicates that **the crosshatched portion is not an uncovered portion of layer 10**, but is a separate layer. Since layer 10 and the crosshatched layer of Fig 2C are formed separately, layer 10 may be a metal of one color, chromium for instance, while the crosshatched layer of Fig 2C may be a metal of a different color, copper for instance. This interpretation is supplied merely to illustrate the examiner's interpretation of what is encompassed in the invention, and is not intended to limit the claims to specific embodiments.

Thirdly, the drawings, as interpreted above, do not correlate with the text of the Appeal Brief. Page 9, lines 18-19 state that the second metallic coating B, of Fig 2B, is formed of "two ... layers (i.e., a layer 10 of nickel and layer 11 of copper)." As stated above, the shading and crosshatching of the Appeal Brief drawings do not indicate that the metallic coating B comprises uncovered layers 10 and 11. The shading of the drawings indicates that the layers of second metallic coating B are formed separately

from layers 10 and 11. The existing discrepancy between drawings, text of the specification, and Counsel's allegations, is exemplary of the discrepancies which have plagued this case.

Fourthly, the text of the Appeal Brief (page 9, lines 15-20; page 12, last paragraph, with respect to claim 25) again seems to indicate that 10 and 11 are included in both the first metallic coating and the second metallic coating. It was explained to Counsel in the interview of July 30, 2003 and in the Final Action dated May 20, 2004 (page 7, lines 7-11) that layers 10, 11 and 12 may either be in the first metallic coating or the second metallic coating, but not in both.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

The rejection of claims 1-15 and 25 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

5505320	Burns
DE 3704403	Mitsubishi
DE 3030403	Rodi
6546751	Jaeger

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. As stated in the previous office action, the term "partially delimiting" is unclear. Since the specification fails to draw a nexus between the layers (6, 10, 11, 12) of figures 2A-2C and 6B and the first and second metallic coatings, the orientation of the coatings and the layers of each coating is unclear. In other words, it is not clear which of the first and second metallic coatings is closer to the support and which one is further away from the support. It is unclear whether the numbering of the coatings is from the surface of the support outward or from the outward surface of the final product in toward the

support. Without knowing the orientation of the coatings and layers, it is unclear in what way the first metallic film "partially delimits" a decorative pattern.

The claims are further indefinite because they are not consistent with the specification and Counsel's arguments. The claims are drawn to two distinct coating systems, while Counsel describes a different interpretation than is gleaned from the claims as drafted.

Claims 2-15 are dependent on claim 1, thus they are also rejected under 35 USC 112, second paragraph.

Claim 25 does not, in fact, contain the terminology used in other claims, therefore the previously stated 112, second paragraph, rejection is withdrawn.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 8-12 and 14-15 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5,505,320 to Burns et al, as stated in the previous office action.

Regarding claims 1 and 25, the Burns reference discloses a support having a first metallic coating of n=2 layers, designated 2 and 3, and a second metallic coating of n=1 layer, designated 4, wherein the outer metallic layer (3) of the first metallic coating

is Cu and has a color and appearance differing from that of the outer metallic layer of the second metallic coating of Cr (col 3, line 22- col 4, line 18). As shown in Figure 5, the first metallic coating delimits a decorative pattern and the second metallic coating corresponds to the decorative pattern.

Regarding claim 2, USPN 4,971,188 to Deters is cited to show that plastics similar to those disclosed by Burns may be metallicity coated by a galvanoplasty process (col 2, lines 8-10 and 45-48). Therefore the limitations of the claim are met.

Regarding claim 3, the Burns reference discloses the object according to claim 1 wherein the support is a polyester (col 2, line 64).

Regarding claims 8-12 and 14-15, the shape of an object is a matter of personal preference predicated on ultimate intended use. Absent an indication of unexpected results with respect to the shape of the object, no patentable distinction is seen.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-15 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 3704403 and DE 3030403.



Each of the cited references teach molded substrates having decorative patterns formed thereon, the decorative patterns defined by at least two metals of contrasting colors. Although the references may not specifically teach the number of claimed layers, no patentable distinction is seen absent a showing of significance with respect to the additional layers of the first metallic coating. The shape of the article to which the decorative metals are applied is merely a matter of personal preference and would have been obvious to one of ordinary skill in the art. Therefore, the limitations of the claims are met.

### ***RESPONSE TO ARGUMENTS***

#### ***35 USC 112, Second Paragraph***

Regarding the rejection of claims 1-15 under 35 USC 112, second paragraph, Applicant asserts that "partially delimiting" is clear to one of ordinary skill in the art. Applicant provides a definition of "delimit," but does not address the actual issue of the orientation of the metallic coatings. The examiner has not withdrawn the rejection because Applicant has not explained which coating is closer to the support and which is further away. Applicant continues to allege that the claim language is clear, but refuses to elaborate on this position to answer the examiner's question regarding the orientation of the coatings. The examiner maintains the rejection in order to obtain a clear record of Applicant's invention, not to further limit the claims in any way.

On pages 15-16, Applicant doesn't understand the previously stated rejection. The examiner's position is that the orientation of the metallic coatings is relative to the way the first coating partially delimits a decorative pattern. The reason that the

orientation is unclear is because the specification does not draw a nexus between the layers in the drawings and those intended as encompassed by each metallic coating. Clarifying which layer is closest to the support would allow one of ordinary skill in the art to know whether the first metallic coating surrounds an area in which the second metallic coating is deposited, or if the first metallic coating is provided on an area and is surrounded by the second metallic coating. Applicant refuses to clearly state where each coating is found with relation to the other and the support.

On page 16 Applicant invokes his right to be his own lexicographer. Firstly, the examiner has never alleged that Applicant has made up words, therefore applicant's argument is not even relevant. Secondly, the examiner agrees that Applicant can make up words and define his invention how he likes, as long as the specification makes clear the claimed invention. The claims are not rejected because, "the terms and expressions in the claims may not be what the Examiner would have selected," as alleged by Applicant on page 17. The claims are rejected because they are not clear; personally favored word choice has in no way influenced the current rejections.

The claims are further rejected as indefinite because they are not consistent with the specification and Counsel's arguments. The claims are drawn to two distinct coating systems, while Counsel describes a different interpretation than is gleaned from the claims as drafted. Applicant's failure to address this particular issue is seen as conceding the rejection.

The Examiner agrees with Applicant's argument that claim 25 does not contain terminology that is consistent with terminology used in other claims, therefore the previously stated 112, second paragraph, rejection is withdrawn.

### ***35 USC 102(b) Rejection over Burns***

The examiner's position regarding the disclosure of Burns remains unchanged, and is stated above in the rejection of the claims.

The examiner disagrees with Applicant's interpretation of how the teachings of the reference compare to the claimed invention. The examiner disagrees because the examiner has interpreted the claims as previously explained in the Non-final office action of 12/23/03, while Applicant seems to interpret a different claimed structure. Examiner's interpretation, verbatim from the Non-Final office action of 12/23/03 is as follows:

The examiner has interpreted the claims, in light of the interview of July 30, 2003, to be drawn to an object comprising a support having at least a first metallic coating formed of at least  $n \geq 2$  superposed layers of metal and defining a decorative pattern and a second metallic coating covering the area corresponding to the decorative pattern and formed of  $n-1$  superposed layers of metal and wherein an outer surface facing away from the support comprises both the first and second metallic coatings and the first metallic coating appears different from the second metallic coating. It is the examiner's interpretation that other layers may be found between any of the claimed layers, as long as the above requirements are met. For instance, a clear protective coating may overlay the first coating as long as the color of the first layer still shows through the discontinuous areas of the second coating. Further, the second coating need not be the outermost coating of the invention; i.e. it is not required that the surface of the second coating be exposed to the environment upon completion of the invention. The second coating may be covered by another layer or coating, including a clear

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layer, another metallic layer, a plastic layer, adhesive layer, or any other layer or coating.

According to the examiner's interpretation of the claims, Burns anticipates the invention. The examiner cannot take a position on how the Burns reference applies to the claims as Applicant interprets them, because it is not clear exactly how Applicant interprets them.

### ***35 USC 103(a) Rejections***

Applicant first contests the Mitsubishi and Rodi references, on page 28, due to a lack of a teaching of a molded support. Applicant also contests the Jaeger reference, on page 32, for the same reason. The molded support was addressed by the statement in the Final Office action, "The shape of the article to which the decorative metals are applied is merely a matter of personal preference and would have been obvious to one of ordinary skill in the art." The rejection will remain until Applicant shows how the shape of the support provides patentable distinction over the teachings of the prior art. If Applicant intends "molded" to imply a process, it is noted that the process limitations are met when the product is the same, regardless of the process used to achieve the final product.

Regarding the motivation to modify the teachings of Mitsubishi or Rodi argued on pages 30-31, it is the examiner's understanding that the modifications are a matter of design choice, and do not affect the utility of the invention. Therefore, personal preference and choice of design are the motivations for modifying the teachings of the


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references. To overcome the rejection, the examiner was requesting evidence that something other than aesthetics are affected by the claim limitations.



Also regarding the Jaeger reference, Applicant attests that two metals of different colors are not apparent on the surface of the invention of Jaeger. Upon further inspection of the reference, the examiner agrees, and the rejection is withdrawn.


For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

  
Arden B. Sperty  
Examiner  
Art Unit 1771

December 22, 2004

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